

**REMARKS**

The Applicants respectfully request reconsideration and allowance of claims 1, 2, and 4-24, in view of the above amendments and the following arguments.

**THE CLAIM AMENDMENTS**

Independent claim 1 has been amended above to incorporate the limitation previously set out in claim 3, and claim 3 has been canceled. Independent claims 10 and 19 have been amended to add a limitation as to the basis of the system configuration commands similarly to claim 1. The remaining dependent claims have been amended as necessary for consistency with the respective dependent claim. Claims 9, 10, 15, 20, 21, and 23 have also been amended above to clarify the subject matter being claimed.

**THE OBJECTION TO SPECIFICATION**

The paragraph of the CROSS REFERENCE SECTION on page one of the specification has been replaced with the above-amended paragraph to include the full serial number and publication number of the related application. The Applicant believes this amendment obviates the Examiner's objection to the disclosure.

**THE OBJECTIONS TO CLAIMS 1, 10, 11, 19, 21, and 23-24**

Claims 1, 10, 11, 19, and 21-24 were objected to because of the use of the transitional term "including" rather than the word "comprising." Applicants respectfully traverse these

1 objections. The transitional term "including" has long been recognized as an appropriate  
2 inclusive, open-ended transitional term and is considered synonymous with the transitional term  
3 "comprising." See M.P.E.P. § 2111.03. In this light, the Applicants respectfully decline to  
4 change the transitional term used in the present claims and respectfully request that the Examiner  
5 withdraw the objection as to the term "including."

6  
7 THE REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

8 The Examiner rejected claims 1-9 under 35 U.S.C. § 112, second paragraph, in view of  
9 an antecedent basis error in claim 1. The Applicants believe the above amendments to claim 1  
10 eliminate the antecedent basis error. Thus, the Applicants believe that claim 1 and its dependent  
11 claims are not objectionable under section 112 and that the indefiniteness rejection should be  
12 withdrawn.

13  
14 THE CLAIMS ARE NOT ANTICIPATED BY WAIN

15 The Examiner rejected claims 1-3, 7-12, 14, 15, and 19-23 under 35 U.S.C. § 102(b) as  
16 being anticipated by U.S. Patent No. 4,335,809 to Wain (the "Wain patent" or "Wain"). The  
17 Applicants believe that the claims as amended above are clearly not anticipated by the Wain  
18 patent.

19 Claims 1, 2, and 4-9

20 Applicants' claim 1 is directed to a gaming system including the following elements.

- 21 (a) a number of gaming machines, each gaming machine including a respective game  
22 presentation arrangement capable of producing any one of a number of unrelated  
23 game presentations;

- 1 (b) a player monitoring arrangement for producing system configuration commands  
2 **based at least partially on a characteristic associated with a player;** and  
3 (c) a game modification controller in communication with the player monitoring  
4 arrangement and with each respective gaming machine, the game modification  
5 controller for receiving system configuration commands from the player  
6 monitoring arrangement and for communicating presentation switching  
7 instructions to one or more of the gaming machines in response to the system  
8 configuration commands, the presentation switching instructions causing the  
9 respective gaming machine to switch from a first game presentation to a second  
10 game presentation. (Emphasis Added)

11 The Wain patent discloses a gaming system in which a game at a gaming machine may be  
12 changed by communications with a remote control device. However, the Wain patent does not  
13 teach or suggest any player monitoring arrangement for producing system configuration  
14 commands based at least partially on a characteristic associated with a player. In contrast to this  
15 requirement of element (b) of claim 1, the Wain patent discloses at Col. 4, beginning at line 59,  
16 that a gaming machine in the system may be modified in the event that signals from the gaming  
17 machine indicate that the machine is not being used frequently. The frequency with which a  
18 gaming machine may be used is not a characteristic associated with a player. Rather, the  
19 frequency with which a gaming machine is used is a characteristic associated with the gaming  
20 machine.

21 It is noted that the disclosure of the present application makes a clear distinction between  
22 the player monitoring arrangement (55 in Applicants' Figure 3) and a usage monitoring controller  
23 (52 in Applicants' Figure 3). As discussed beginning at page 25, line 16 of the Applicants'  
24 disclosure. The player monitoring arrangement 55 in Applicants' gaming system is shown as  
25 including player location tracking controller 56, player tracking system 58, player preference  
26 tracking controller 57, and player data collection system 59. These components 56, 57, 58, and

59 all relate to collecting or monitoring information regarding the players in the casino, that is, player characteristic information. However, it is the usage monitoring controller 52 in Applicants' invention that monitors the usage of the various gaming machines in the system. Given the distinction in the Applicants' disclosure regarding the player monitoring arrangement 55 which monitors for player characteristics and the usage monitoring controller 52 which monitors gaming machine usage, the limitation now set out at element (b) of claim 1 regarding producing system configuration commands based at least partially on a characteristic associated with a player, simply cannot be reasonably interpreted to encompass the frequency with which a gaming machine is used as disclosed in the Wain patent.

Because the Wain patent does not teach a player monitoring arrangement as required at element (b) of claim 1, the reference cannot anticipate claim 1 or the claims depending from claim 1, claims 2 and 4-9.

Claims 10-18 and 19-24

Independent claims 10 and 19 have been amended to include limitations regarding producing a system configuration command at least partially based on a characteristic associated with a player similar to the requirement in claim 1. Thus, the comments set out above with respect to claim 1 apply with equal force to claims 10 and 19, and their respective dependent claims.

For all of these reasons the Applicants submit that the claims as amended are not anticipated by the Wain patent.

1 THE CLAIMS ARE NOT ANTICIPATED BY ITKIS

2 The Examiner rejected claims 1-4 and 7-24 under 35 U.S.C. § 102(b) as being  
3 anticipated by U.S. Patent No. 4,856,787 to Itkis (the "Itkis patent" or "Itkis"). The Applicants  
4 respectfully submit that the claims are not anticipated by the Itkis patent.

5 Claims 1, 2, and 4-9

6 As discussed above, claim 1 requires a gaming system that includes, among other  
7 elements, a player monitoring arrangement for producing system configuration commands based  
8 at least partially on a characteristic associated with a player. This "player monitoring  
9 arrangement" is described in the Applicants' disclosure particularly beginning at page 25, line 16.  
10 The Itkis patent does not teach or suggest any element for producing system configuration  
11 commands based at least partially on a characteristic associated with a player.

12 In the rejections based on the Itkis patent, the Office Action indicates starting at the next  
13 to the last line of page 6 that the Itkis patent "includes a player monitoring arrangement for  
14 producing configuration commands based at least partially upon player characteristics (player  
15 preferred game or game level)...." The Office Action does not point to any support in the Itkis  
16 patent for this proposition regarding a player monitoring arrangement. The Applicants  
17 respectfully submit that Itkis provides no such support for this statement in the Office Action.  
18 Thus, there no basis for the rejection of claim 1 as amended above as being anticipated by the  
19 Itkis patent. Claim 1 now clearly requires a player monitoring arrangement for producing system  
20 configuration commands based at least partially on a characteristic associated with a player, and  
21 Itkis does not teach or suggest any such player monitoring arrangement.

1 Furthermore, the Itkis patent fails to teach or suggest element (c) of claim 1 as amended.  
2 Element (c) of claim 1 requires a game modification controller in communication with the player  
3 monitoring arrangement and with each respective one of the number of gaming machines. The  
4 game modification controller receives system configuration commands from the player  
5 monitoring arrangement and communicates presentation switching instructions to one or more of  
6 the gaming machines in response to the system configuration commands. These presentation  
7 switching instructions cause the respective gaming machine to switch from a first game  
8 presentation to a second game presentation. However, it is apparent from the discussion from  
9 line 15 to line 34 of column 3 in Itkis that there is no switching between two game presentations  
10 in the Itkis system. Rather, each different game available at an Itkis slave game device is simply  
11 displayed in a respective window at the slave game device.

12 For all of these reasons, the Applicants submit that claim 1 is not anticipated by the Itkis  
13 patent and that claim 1 and its dependent claims, claims 2 and 4-9, are each entitled to allowance  
14 over the Itkis patent.

15 It is noted that the Itkis patent also fails to teach or suggest many of the features set out in  
16 the claims depending from claim 1. For example, even assuming for the sake of argument that  
17 the Examiner is correct in likening the smart card reader disclosed in Itkis as a player tracking  
18 controller, there is no suggestion that the smart card reader in Itkis produces system configuration  
19 commands based in any way on the player's location. Rather, as discussed at the bottom of  
20 column 1 and top of column 2 in Itkis, the smart card is used merely as a data storage device.  
21 Thus, claim 4 is also clearly not anticipated by the Itkis patent.

22

1     Claims 10-18 and 19-24

2             As discussed above in connection with the comments regarding the rejections based on  
3     the Wain patent, independent claims 10 and 19 have been amended to include limitations  
4     regarding producing a system configuration command at least partially based on a characteristic  
5     associated with a player similar to the requirement in claim 1. Thus, the comments set out above  
6     with respect to the differences between the system disclosed in the Itkis patent and the invention  
7     set out in claim 1 apply with equal force to claims 10 and 19, and their respective dependent  
8     claims.

9             For all of these reasons the Applicants submit that claims 10-24 as amended are also not  
10    anticipated by the Itkis patent.

11  
12    **CLAIMS 5 AND 6 ARE PATENTABLE OVER THE ITKIS AND SIZER PATENTS**

13            The Examiner rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable  
14    over Itkis in view of U.S. Patent No. 5,923,252 to Sizer et al. (The "Sizer patent" or "Sizer").  
15    The Applicants respectfully traverse these rejections on the ground that the proposed  
16    combination does not teach or suggest each and every limitation set forth in the claims.

17            Sizer was cited to show a signal reading device for remotely reading identifying  
18    information carried by a player (claim 5) or a number of signal reading devices for remotely  
19    receiving identifying signals originating from a device carried by the player (claim 6). However,  
20    claims 5 and 6 do not merely require one or more signal reading devices. As discussed in detail  
21    above, claim 1, from which claims 5 and 6 depend, requires a player monitoring arrangement.  
22    The player monitoring arrangement functions to produce system configuration commands based

1 at least partially on a characteristic associated with a player. Furthermore, claim 1 requires a  
2 game modification controller that communicates presentation switching instructions to one or  
3 more of the system gaming machines in response to the system configuration commands to  
4 switch game presentations at the respective gaming machines. As discussed above, the Itkis  
5 patent does not teach or suggest these elements of claim 1. The Sizer patent certainly does not  
6 make up for these deficiencies of Itkis. The Sizer patent does not teach or suggest producing  
7 system configuration commands based at least in part on characteristics of a gaming system  
8 player, and does not teach or suggest any element for issuing instructions to switch game  
9 presentations at any gaming machine.

10 Because neither Itkis nor Sizer teach or suggest the player monitoring arrangement  
11 required in claim 1 or the game modification controller required in claim 1, the proposed  
12 combination of references cannot teach or suggest all of the elements required in the present  
13 claims and cannot render the present claims obvious under 35 U.S.C. § 103.

14 For all of these reasons, Applicants submit that claims 5 and 6 are not obvious over the  
15 proposed combination of Itkis and Sizer and are entitled to allowance together with the other  
16 claims in the case.



## 1 CONCLUSION

2 For all of the above reasons the Applicants respectfully request reconsideration and  
3 allowance of claims 1, 2, and 4-24.

4 If any issue remains as to the allowability of these claims, or if a conference might  
5 expedite allowance of the claims, the Examiner is asked to telephone the undersigned attorney  
6 prior to issuing a further action in this case.

7  
8 Respectfully submitted,

9 THE CULBERTSON GROUP, P.C.

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23 CERTIFICATE OF FACSIMILE

24 I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (Fax  
25 No. 703-872-9306) on March 31, 2005.

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